

# **Manual of PATENT EXAMINING PROCEDURE**

Original Eighth Edition, August 2001

Latest Revision July 2010



**U.S. DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

The U.S. Patent and Trademark Office does not handle the sale of the Manual, distribution of notices and revisions, or change of address of those on the subscription list. Correspondence relating to existing subscriptions should be sent to the Superintendent of Documents at the following address:

Superintendent of Documents  
Mail List Section, Washington, DC 20402

Telephone: 202-512-2267

Inquiries relating to purchasing the Manual should be directed to:

Superintendent of Documents  
United States Government Printing Office  
Washington, DC 20402

Telephone: 202-512-1800

Orders for reproduced copies of individual replacement pages or of previous revisions of the Manual should be sent to the following address:

Mail Stop Document Services  
Director of the U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Telephone: 1-800-972-6382 or 571-272-3150

Previous editions and revisions of the Manual are available on microfilm in the Patent Search Room.  
The Manual is available on CD-ROM and on diskette from:

U.S. Patent and Trademark Office  
Office of Electronic Information Products  
MDW 4C18, P.O. Box 1450  
Alexandria, VA 22313-1450

Telephone: 571-272-5600

Employees of the U.S. Patent and Trademark Office should direct their requests for the Manual, replacement pages, notices, and revisions to the Office of Patent Training.

Telephone: 571-272-7222

Pursuant to the Patent and Trademark Office Efficiency Act (PTOEA) (Pub. L. 106-113, 113 Stat. 1501A-572), the head of the United States Patent and Trademark Office (USPTO) is the "Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office." The Director is assisted by the "Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office." The patent operations of the USPTO are now headed by the "Commissioner for Patents." The trademark operations of the USPTO are now headed by the "Commissioner for Trademarks." Under section 4741(b) of the PTOEA, any reference to the Commissioner of Patents and Trademarks, the Assistant Commissioner for Patents, or the Assistant Commissioner for Trademarks is deemed to refer to the Director, the Commissioner for Patents, or the Commissioner for Trademarks, respectively. See "Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office" published in the *Federal Register* at 65 FR 17858 (Apr. 5, 2000), and in the *Official Gazette of the United States Patent and Trademark Office* at 1234 O.G. 41 (May 9, 2000).

Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (\*) where a single word was deleted and by two asterisks (\*\*) where more than one word was deleted. The use of three or five asterisks in the body of the laws, rules, treaties, and administrative instructions indicates a portion of the law, rule, treaty, or administrative instruction which was not reproduced.

First Edition, November 1949  
Second Edition, November 1953  
Third Edition, November 1961  
Fourth Edition, June 1979  
Fifth Edition, August 1983  
Sixth Edition, January 1995  
Seventh Edition, July 1998  
Eighth Edition, August 2001  
Revision 1, February 2003  
Revision 2, May 2004  
Revision 3, August 2005  
Revision 4, October 2005  
Revision 5, August 2006  
Revision 6, September 2007  
Revision 7, July 2008  
Revision 8, July 2010

## Chapter 2200 Citation of Prior Art and Ex Parte Reexamination of Patents

2201	Introduction	2242	Criteria for Deciding Request
2202	Citation of Prior Art	2243	Claims Considered in Deciding Request
2203	Persons Who May Cite Prior Art	2244	Prior Art on Which the Determination Is Based
2204	Time for Filing Prior Art Citation	2245	Processing of Decision
2205	Content of Prior Art Citation	2246	Decision Ordering Reexamination
2206	Handling of Prior Art Citation	2247	Decision on Request for Reexamination, Request Denied
2207	Entry of Court Decision in Patent File	2247.01	Examples of Decisions on Request for Reexamination
2208	Service of Citation on Patent Owner	2248	Petition From Denial of Request
2209	<i>Ex Parte</i> Reexamination	2249	Patent Owner's Statement
2210	Request for <i>Ex Parte</i> Reexamination	2250	Amendment by Patent Owner
2211	Time for Requesting <i>Ex Parte</i> Reexamination	2250.01	Correction of Patent Drawings
2212	Persons Who May File a Request for <i>Ex Parte</i> Reexamination	2250.02	Correction of Inventorship
2212.01	Inquiries from Persons Other Than the Patent Owner	2250.03	Fees for Adding Claims
2213	Representative of Requester	2251	Reply by Third Party Requester
2214	Content of Request for <i>Ex Parte</i> Reexamination	2252	Consideration of Statement and Reply
2215	Fee for Requesting <i>Ex Parte</i> Reexamination	2253	Consideration by Examiner
2216	Substantial New Question of Patentability	2254	Conduct of <i>Ex Parte</i> Reexamination Proceedings
2217	Statement in the Request Applying Prior Art	2255	Who Reexamines
2218	Copies of Prior Art	2256	Prior Art Patents and Printed Publications Reviewed by Examiner in Reexamination
2219	Copy of Printed Patent	2257	Listing of Prior Art
2220	Certificate of Service	2258	Scope of <i>Ex Parte</i> Reexamination
2221	Amendments Included in Request by Patent Owner	2258.01	Use of Previously Cited/Considered Art in Rejections
2222	Address of Patent Owner	2259	<i>Res Judicata</i> and Collateral Estoppel In Reexamination Proceedings
2223	Withdrawal of Attorney or Agent	2260	Office Actions
2224	Correspondence	2260.01	Dependent Claims
2225	Untimely Paper Filed Prior to Order	2261	Special Status For Action
2226	Initial Processing of Request for <i>Ex Parte</i> Reexamination	2262	Form and Content of Office Action
2227	Incomplete Request for <i>Ex Parte</i> Reexamination	2263	Time for Response
2229	Notice of Request for <i>Ex Parte</i> Reexamination in <i>Official Gazette</i>	2264	Mailing of Office Action
2230	Constructive Notice to Patent Owner	2265	Extension of Time
2231	Processing of Request Corrections	2266	Responses
2232	Public Access	2266.01	Submission Not Fully Responsive to Non-Final Office Action
2232.01	Determining if a Reexamination >Request< Was Filed for a Patent	2266.02	Examiner Issues Notice of Defective Paper in <i>Ex Parte</i> Reexamination
2233	Processing in Central Reexamination Unit and Technology Center	2266.03	Service of Papers
2234	Entry of Amendments	2267	Handling of Inappropriate or Untimely Filed Papers
2235	Record Systems	2268	Petition for Entry of Late Papers for Revival of Reexamination Proceeding
2236	Assignment of Reexamination	2269	Reconsideration
2237	Transfer Procedure	2270	Clerical Handling
2238	Time Reporting	2271	Final Action
2239	Reexamination Ordered at the Director's Initiative	2271.01	Panel Review
2240	Decision on Request	2272	After Final Practice
2241	Time for Deciding Request		

of 37 CFR 1.116(b) will be strictly enforced after final action and that any amendment after a final action must include “a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented” in order to be considered. The language of form paragraph 22.04 is appropriate for inclusion in the first Office action:

**¶ 22.04 Papers To Be Submitted in Response to Action - Ex Parte Reexamination**

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116 after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

## 2260.01 Dependent Claims [R-2]

If \*\* >an unamended base patent claim (i.e., a claim appearing in the reexamination as it appears in the patent)< has been rejected or canceled, any claim which is directly or indirectly dependent thereon should be confirmed or allowed if the dependent claim is otherwise allowable. The dependent claim should *not* be objected to or rejected merely because it depends on a rejected or canceled patent claim. No requirement should be made for rewriting the dependent claim in independent form. As the original patent claim numbers are not changed in a reexamination proceeding, the content of the canceled base claim would remain in the printed patent and would be available to be read as a part of the confirmed or allowed dependent claim.

If a new base claim (a base claim other than a base claim appearing in the patent) has been canceled in a reexamination proceeding, a claim which depends thereon should be rejected as \*>indefinite<. If a new base claim >or an amended patent claim< is rejected, a claim dependent thereon should be objected to if it is otherwise patentable and a requirement made for rewriting the dependent claim in independent form.

## 2261 Special Status for Action

35 U.S.C. 305. *Conduct of reexamination proceedings.*

\*\*\*\*\*

All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

In view of the requirement for “special dispatch,” reexamination proceedings will be “special” throughout their pendency in the Office. The examiner’s first action on the merits should be completed within *1 month* of the filing date of the requester’s reply (37 CFR 1.535), or within *1 month* of the filing date of the patent owner’s statement (37 CFR 1.530) if there is no requester other than the patent owner. If no submissions are made under either 37 CFR 1.530 or 37 CFR 1.535, the first action on the merits should be completed within *1 month* of any due date for such submission. Mailing of the first action should occur within 6 WEEKS after the appropriate filing or due date of any statement and any reply thereto.

Any cases involved in litigation, whether they are reexamination proceedings or reissue applications, will have priority over all other cases. Reexamination proceedings not involved in litigation will have priority over all other cases except reexaminations or reissues involved in litigation.

## 2262 Form and Content of Office Action [R-7]

The examiner’s first Office action will be a statement of the examiner’s position and should be so complete that the second Office action can properly be made a final action. See MPEP § 2271.

All Office actions are to be typed. The first Office action must be sufficiently detailed that the pertinency and manner of applying the cited prior art to the claims is clearly set forth therein. Where the request for reexamination includes material such as a claim chart to explain a proposed rejection in order to establish the existence of a substantial new question of patentability, the examiner may cut and paste the claim chart (or other material) to incorporate it within the body of the Office action. The examiner must, however, carefully review the claim chart (or other material) to ensure that any items incorporated in a statement of the rejection clearly and completely address the patentability of the claims. For actions subsequent to the first Office action, the examiner must be careful to additionally address all patent owner responses to previous actions. If the examiner concludes in any Office action that one or more of the claims are patentable over the cited patents or printed publications, the examiner should indicate why the claim(s) is clearly patentable in a manner similar to